

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/363,499 07/29/99 SUTTON

D 9204-000001

TM02/0522
HARNESS DICKEY AND PIERCE PLC
P O BOX 828
BLOOMFIELD HILLS MI 48303

EXAMINER

BERGIN, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/363,499

Applicant(s)

SUTTON ET AL.

Examiner

James S. Bergin

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group 1, claims 1-9 and Species A (figs. 3, 4A and 4B as claimed in claims 2-4) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the examiner has not shown that there would be a serious burden on the examiner if the restriction between the inventive groups and species had not been required. The applicant states that *"regardless of which set of claims are prosecuted, the field of search for each invention will substantially overlap, if not be identical to, the other."* This is not found persuasive because although the examiner has indicated that the inventions of group I and II are can both be properly classified in 705/26, and each has an overlapping search requirement in this class/subclass, the search for each group then substantially diverges and involves different search areas and strategies in other relevant areas of the US classification system, EPO database, JPO database, Derwents World patent index and numerous other commercial databases accessed via dialog. The independent claim of group I does not limit the acquisition of the intermediary credit account information by the purchaser to take place between a first and second computer of a computer network, and includes the possibility that the intermediary credit account information could simply be provided to the purchaser by physically presenting him/ her with a non-electronic prepaid credit card. The search area for a non-virtual prepaid credit card substantially diverges from the search area for a virtual prepaid credit card. The search for group I involves a search strategy involving the non-electronic provision of non-electronic prepaid credit

Art Unit: 2164

cards, such a search not being required by group II. The examiner finds this to be **unduly burdensome** and has imposed the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to because Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Correction is required.

Specification

3. The use of the trademarks WalMart, Rite-aid, Citibank, and BancOne has been noted in this application. They should be capitalized wherever they appear.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-4 and 7-9** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 10 and 11, "the purchaser" lacks a proper antecedent basis. It is also unclear if "the purchaser" is the same entity as the "purchasing intermediary" or if

Art Unit: 2164

"the purchaser" is a separate entity? Furthermore, claim 1 is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: steps linking the "at least two computing devices interconnected by a network" to the "acquiring", "providing" and "transacting" steps of the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. **Claims 1-4** are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (5,883,810).

Franklin et al. disclose a purchasing system having at least two computing devices interconnected by a network (fig. 1) comprising the steps of: acquiring intermediary credit account information such as an online virtual credit card having a credit card number and a proxy transaction number associated therewith, from a purchasing intermediary (col. 4, lines 24-47); providing purchase transactional information including at least some of the intermediary credit account information to a retailer (col. 4, lines 48-65); and transacting a purchase between the purchaser and the retailer using the intermediary credit account information. The anonymity of the purchaser is maintained because only the proxy transaction number is revealed to the

Art Unit: 2164

purchaser with the real number of the virtual credit card being retained by the purchasing intermediary.

Regarding **claim 2**, Franklin et al. disclose that the purchaser provides personal credit card/ account information to the purchasing intermediary as part of the application/ registration phase for the virtual credit card.

Regarding **claim 3**, the virtual credit card has a credit limit associated therewith (col. 11, line 22-31).

Regarding **claim 4**, the "real" credit card account of the purchaser has a valid credit card number and expiration data and is debit an amount no less than the credit limit associated with the issued virtual credit card.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 7 and 8** rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (5,883,810) in view of Walker et al. (5,794,207).

Franklin et al. disclose a purchasing system as described above. However, the Franklin et al. patent does not specifically disclose that the intermediary credit account information includes an intermediary shipping address to which address the retailer forwards the purchased item.

Art Unit: 2164

Walker et al. disclose a purchasing system which involves the use of trusted third party intermediaries having intermediary shipping addresses which provide a relay system for the delivery of goods and services to the purchaser and which thereby allows the purchaser to remain anonymous from the retailer (col. 7, lines 52-58).

It would have been obvious, in view of Walker et al., to one of ordinary skill in the art at the time that the invention was made, to provide the virtual credit card of the Franklin et al. purchasing system with an intermediary shipping address so as to enable the purchaser to remain anonymous from the retailer.

10. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (5,883,810) in view of Biffar (5,903,880).

Franklin et al. disclose a purchasing system as described above. However, this patent does not specifically suggest the provision of discount coupons to the purchaser at the time of acquisition of the intermediary credit account information.

Biffar discloses a payment system wherein the identity of the payer remains anonymous comprising the circulation of digital vouchers. Biffar further discloses that coupons and other data items can be added to the digital payment vouchers of the payment system so as to allow the payment system to additionally provide purchasing incentives and customer loyalty functions and thereby operate as a multiple purpose system (col. 5, lines 19-24).

It would have been obvious, in view of Biffar, to one of ordinary skill in the art at the time that the invention was made, to include in the Franklin et al. system, the provision of discount coupons to the purchaser during the step of acquisition of the

Art Unit: 2164

online virtual credit card by the purchaser, thereby enabling the Franklin et al. purchasing system to provide purchasing incentives and to serve a multiple purpose role.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arditti et al. (5,991,413) discloses a relevant virtual prepaid card ; Koppel et al. (WO 01/03033 A; note this document claims priority to US application 09/346,317 filed on 7/2/1999, a date prior to applicant's filing date) discloses a relevant prepaid electronic debit card compatible with the existing network of credit cards; Slavin et al. (5,819,234) discloses a relevant prepaid credit account for making anonymous payments; Low et al. (5,420,926) discloses a system for performing anonymous credit card transactions; "The Internet Commission" (web page, publication date unknown) discloses a prepaid credit card issued by the Mastercard Corporation and sold at all major retail outlets; and "Ambalink Launches Secure Online Shopping in the UK" (6/8/1999) discloses a system involving a purchasing intermediary wherein the retailer does not receive or hold the purchaser's credit card details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers

• Art Unit: 2164

for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

James S. Bergin

A handwritten signature in cursive script, appearing to read "J S Bergin", followed by a horizontal line.

May 18, 2001

A handwritten signature in cursive script, appearing to read "Vincent Millin", positioned above a rectangular stamp.

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100